



Application no. 10/058,473

2823
#4
Election
6/26/03
Michelle

June 16, 2003

TO: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 2823 - Examiner Michelle Estrada

FROM: George O. Saile, Reg. No. 19,572
28 Davis Avenue
Poughkeepsie, N.Y. 12603

SUBJECT: Serial #: 10/058,473 ✓
File Date: Jan. 28, 2002
Inventor: Ken Chen
Examiner: Michelle Estrada
Art Unit: 2823
Title: Enhanced Adhesion Strength between Mold Resin and Polyimide

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TECHNOLOGY CENTER 2823

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This is in response to the Restriction Requirement in the Office Action dated May 16, 2003. In that office action, restriction was required to one of the following Inventions under

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450, Alexandria, VA 22313-1450 on June 16, 2003.

Signature 
Stephen B. Ackerman, Reg. No. 37,761

Date: June 16, 2003

35 U.S.C. 121:

The inventions stated are:

I - Claims 1-5 and 11-31, drawn to a process of making a semiconductor device, classified in class 438, subclass 124, and

II - Claims 6-8, drawn to a semiconductor device, classified in class 257, subclass 678, and

III – Claims 9-10, drawn to a semiconductor device, classified in class 257, subclass 787.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-5 and 11-31 drawn to a process classified in Class 438, subclass 124. This election is made with traverse of the requirement under 37 C.F.R. 1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction in the Office Action.

The Examiner gives the reasons for the distinctness between Inventions I and II as
(1) that the process as claimed can be used to make other and materially different

Preamble

product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of forming "creating an interface layer over the surface of a semiconductor device", and that the product claims are directed to "an interface layer created over the surface of a semiconductor device", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 438/124 and product class/subclass 257/678, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "the product as claimed can be made by another and materially different process such as one that does not comprise conductive interconnections between points of electrical contact" is speculative and has nothing to do with the Claims as presented in this patent application.

preamble

The Examiner gives the reasons for the distinctness between Inventions I and III as (1) that the process as claimed can be used to make other and materially different product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of forming "creating an interface layer over the surface of a semiconductor device", and that the product claims are directed to "Protective layers provided for the packaging of a semiconductor a device", and that it is necessary to obtain claims in both the process and

product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 438/124 and product class/subclass 257/787, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and III are clearly and necessarily co-extensive. The Examiner's suggestion that "the product as claimed can be made by another and materially different process such as one that comprises depositing a layer of mold compound over the surface of the interface layer, filling at least one opening created through the interface layer" is speculative and has nothing to do with the Claims as presented in this patent application.

Preamble

The Examiner states that Inventions II and III are related as combination and subcombination, and gives as the reasons for distinctness that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). However, upon reading the Invention II Claims against the Claims of Invention III, it can be seen that Invention III is drawn to "protective layers provided for the packaging of a semiconductor device", while Invention II is drawn to an interface layer created over the surface of a semiconductor device". As such, the field of search must necessarily cover both the Group II class/subclass 257/678 and the Group III class/subclass 257/787, in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group II and Group III inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "the combination does not require a semiconductor device having a first and second surface with points of electrical

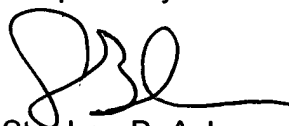
contact" is speculative and has nothing to do with the Claims as presented in this patent application.

Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of second and third patent applications upon the applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement, and allowance of the present Patent Application, is respectfully requested.

It is requested that should there be any problems with this response, please call the undersigned Attorney at (845) 452-5863.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'SBA', with a long horizontal flourish extending to the right.

Stephen B. Ackerman, Reg. No. 37,761